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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/629,746 | 07/30/2003 | Leonid Bravinski | 92953-7 | 6812 |

22463 7590 09/29/2006

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| EXAMINER |
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SPAHN, GAY

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| ART UNIT | PAPER NUMBER |
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3635

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,746

Applicant(s)

BRAVINSKI, LEONID

Examiner

Gay Ann Spahn

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-71 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-45, 52, and 55-68, drawn to a system or formwork assembly for fabricating a slab, classified in class 249, subclass 18.
- II. Claim 46, drawn to a slab, classified in class 52, subclass 326.
- III. Claims 47-51 and 53-54, drawn to a method for fabricating a slab, classified in class 264, subclass 35.
- IV. Claims 69-71, drawn to support member for use in supporting a slab, classified in class 52, subclass 729.5.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because The claimed combination does not require the reinforcement member to be interconnected to the panel member. The subcombination has separate utility such as use by itself as a barrier layer.

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

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practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case claimed apparatus can be mounted to or as a subceiling to provide for insulation.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claimed combination does not require a supporting member having spaced apart apertures. The subcombination has separate utility such as use by itself as a sustainer with any given building component.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case claimed product can be constructed by merely placing the panel member with reinforcement along an upper surface of the structural supporting members.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and

(2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claimed combination does not require a supporting member having spaced apart apertures. The subcombination has separate utility such as use by itself as a sustainer with any given building component.

Inventions IV and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case claimed process can utilize a solid-web supporting member.

Election/Restrictions - Election of Species Requirement

This application contains claims directed to the following patentably distinct species:

- SPECIES I - Fig. 1;
- SPECIES II - Fig. 4;
- SPECIES III - Fig. 5;
- SPECIES IV - Fig. 6;
- SPECIES V - Fig. 7;
- SPECIES VI - Fig. 8a;
- SPECIES VII - Fig. 9a; OR
- SPECIES VIII - Fig. 10;

The species are independent or distinct because:

SPECIES I (i.e., Fig. 1) discloses a form panel unit (110) comprising a foam plastic perforated panel (112) between supporting beams (140) and supporting transversely spaced reinforcement units (122);

SPECIES II (i.e., Fig. 4) discloses a form panel unit (210) comprising a foam plastic perforated panel (212) between supporting beams (240) and supporting transversely spaced reinforcement units (222);

SPECIES III (i.e., Fig. 5) discloses a form panel unit (310) comprising a foam plastic perforated panel (312) between supporting beams (340) and supporting transversely spaced reinforcement units (322);

SPECIES IV (i.e., Fig. 6) discloses a form panel unit (410) comprising a foam plastic perforated panel (412) between supporting beams (440) and supporting transversely spaced reinforcement units (422);

SPECIES V (i.e., Fig. 7) discloses a form panel unit (510) comprising a foam plastic perforated panel (512) between supporting beams (540) and supporting transversely spaced reinforcement units (522);

SPECIES VI (i.e., Fig. 8a) discloses a form panel unit (610) comprising a foam plastic perforated panel (612) between supporting beams (640) and supporting transversely spaced reinforcement units (622);

SPECIES VII (i.e., Fig. 9a) discloses a form panel unit (710) comprising a foam plastic perforated panel (712) between supporting beams (740) and supporting transversely spaced reinforcement units (722); and

SPECIES VIII (i.e., Fig. 10) discloses a form panel unit (710) comprising a foam plastic perforated panel (712) between supporting beams (840) and supporting transversely spaced reinforcement units (722).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, independent claims 1, 36, 46, 47, 52, 53, 55, and 69 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).


A telephone call was not made to request an oral election to the above Restriction Requirement and Election of Species Requirement due to the complexity of the election.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko N. Slack can be reached on (571)-272-6848. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gay Ann Spahn, Patent Examiner
September 26, 2006

Robert Canfield
Primary Examiner

